



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,567	07/31/2000	Li Wen Liu	A-69366/MAK/LM	4144

7590 01/14/2004  
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP  
Suite 3400  
Four Embarcadero Center  
San Francisco, CA 94111-4187

EXAMINER
----------

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/628,567

Applicant(s)

LIU ET AL.

Examiner

Allyson N Sanders

Art Unit

2876

AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the Amendment filed July 21, 2003.
2. The indicated allowability of claims 13-15 from the previous Office Action (paper no. 9) is withdrawn in view of recognition that Harms et al (6,070,147) teaches the subject matter of claims 13-15. The delay in citation of the above art is regretted. Rejections based on the above identified prior arts follow. **Therefore, this action is not made Final.**

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
4. Claims 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Harms et al (6,070,147).

Harms et al teaches the following in regards to claims 13-15:

“The present invention relates to transaction processing and analysis systems, including check verification systems and frequent-buyer marketing programs, and to the capture of a consumer's name and other information through government-issued identification card. In particular, the present invention relates to the use of such an identification system in connection with marketing applications.” (Col. 1, lines 5-11)

“The equipment shown in FIG. 1 is, in one embodiment of the present invention, located at the point of sale in a retail store, such as at a check-out counter, or the like. Cash register 3 could be a prior art cash register, such as one that is located at the check-out line at a retail outlet. Register 3 operates in connection with a bar code reader 6, which identifies the product being purchased by a consumer. The bar code read from the product that the consumer wishes to purchase is communicated to the cash register 3, and the register 3 then accesses a database to determine the identity of the product and the price of the product, in the manner known in the art. Instead of automatically reading the bar code, the retail clerk typically can manually type into the cash register the product number that the bar code represents.” (Col. 4, lines 15-29).

“A credit card reader 9 also operates in conjunction with the cash register 3. When the consumer approaches the check-out counter, the retail clerk at the counter uses the card reader 9 to charge the cost of the product to the consumer's credit card account. As is known in the art, when the card reader reads the credit card number, a remote database is accessed to verify the consumer's credit, and to log the charge on the consumer's account. Although a credit card reader is shown, payment could

Art Unit: 2876

obviously be made by any other type of payment card (e.g., a debit card, or an electronic commerce card), by cash, or by check using an automatic check reading and verification system." (Col. 4, lines 30-41).

"The typical consumer will regularly carry a government-supplied identification card with him or her for use if needed. The potential participants in a loyalty marketing program are exposed to the merchant's program through personal conversation, advertising, or signage. The consumer who decides to participate in the program voluntarily provides his or her government card for passing ("swiping") through the terminal device to log the identity of the consumer at the identification terminal 15 location. The initial enrollment may be in connection with a purchase of goods at the merchant's location, but it need not be. The identification terminal 15 may also optionally allow the consumer (or retail clerk) to key-in additional data about the participant, the transaction, the participant's opinions, or other desired information, as prompted by the prompt queries displayed on the identification terminal 15. The prompts may also ask for the price and identity of the product being purchased, if this information is not otherwise received from the cash register 3." (Col. 6-24).

"Also shown in FIG. 11 is the step of transmitting an advertisement to the point of sale for display to the consumer. Since the consumer database provides insight into the consumer's spending habits, it is possible to provide personalized advertisements that would likely appeal to the consumer, based on the consumer's prior purchases. Thus, in one embodiment, the central processing system may direct the equipment of FIG. 1 to display print or advertising messages based on the member's purchase patterns,

Art Unit: 2876

location, demographics, or the like. These advertising messages can be placed on a receipt, or displayed on a screen visible to the consumer. In addition, the consumer database created with the present invention can be used to segment and create mailing lists for earning statements, personalized direct mail, mailing labels, and other targeted advertising to support the loyalty program or other marketing efforts of the program sponsor or its affiliates." (Col. 11, lines 44-60).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Paschini (2003/0095646) and Forsythe et al (6,540,137).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson Sanders* whose telephone number is (703) 305-5779. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 872-9306.

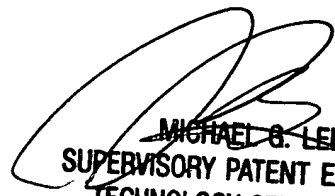
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.sanders@uspto.gov](mailto:allyson.sanders@uspto.gov)].

*All Internet e-mail communications will be made of record in the application file.*  
*PTO employees do not engage in Internet communications where there exists a*

*possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Allyson Sanders  
Patent Examiner  
Art Unit 2876  
November 4, 2003



MICHAEL S. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800